

Notice of Allowability

Application No.

09/701,011

Examiner

Marc S. Zimmer

Applicant(s)

ANDO ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--
All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 09/11/03.
2. ☒ The allowed claim(s) is/are 3-10.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. _____. |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____. | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

EXAMINER'S AMENDMENT

An extension of time under 37 CFR 1.136(a) is required in order to make an examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on 09/11/03, Dan Geselowitz requested an extension of time for 1 MONTH(S) and authorized the Director to charge Deposit Account No. 012340 the required fee of \$110.00 for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

In line 7 of claim 3, please remove "(d)".

In the last line of claim 3, please replace the phrase "is not contained." with

-- is excluded from the curing agent composition. --

In a telephone interview with Mr. Geselowitz, the Examiner asked that he point out support for the added subject matter of claim 3 in the original disclosure because it was believed that the Specification did not expressly enable the invention where a particular class of materials was to be left out of the curing agent composition. The Examiner was directed to the first sentence of the second paragraph of page 48 where it is indeed indicated that (a), (b), and (c) are not to be blended together with a silyl group-functionalized resin (referred to as a base resin in that instance).

Upon obtaining evidence that the amendment was supported, the Examiner expressed concern that the added proviso was perhaps problematic because it served to exclude a fourth component (d) wherein (d) was a polymer having groups crosslinkable by divalent tin yet (a) was disclosed broadly enough that it would be inclusive of a polymer having groups crosslinkable by divalent tin. That is, the claim appeared to suggest that an ingredient (d) should be left out of the formulation that (a) would encompass. After much deliberation, Applicant suggested simply removing recitation of "(d)" thereby changing the scope of the claim such that none of (a), (b), (c), or another ingredient not expressly delineated (but available to the composition in view of Applicant's usage of the transitional phrase "comprising") could be an organic polymer having in its molecule a group that is crosslinkable by divalent tin.

Both *Proebster* and *Hasegawa* disclose compositions containing (a), (b), and (c) but also an organic polymer having groups crosslinkable by divalent tin. There is no suggestion that the materials might be divided into two parts wherein the polymer material is physically separated from the other ingredients. Therefore, Applicant has successfully overcome the art rejections.

A subsequent survey of the prior art did not yield a reference teaching a mixture of (a), (b), and (c) to the exclusion of a silane-functionalized polymer. (While there is ample precedent for the division of curable compositions into two parts to preclude premature crosslinking of their components while in storage, there is no teaching of a two-part composition wherein the one of the parts is constituted precisely of the material

recited in claim 3.) Accordingly, claims 3-6 are now allowable. Reasons for the allowability of claims 7-10 were offered in paper numbers 5 and 11.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

September 15, 2003



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700